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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/512,223 02/24/00 MIEHLING M 104142

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| EXAMINER |
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| DINH.T | |
| ART UNIT | PAPER NUMBER |

2841

DATE MAILED:

08/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/512,223

Applicant(s)

MIEHLING, MARTIN

Examiner

Tuan T Dinh

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 16-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's election with traverse of Group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the searches for Groups I and II would be co-extensive. This is not found persuasive because the method of manufacturing a transponder (claims 16-29) would be classified in a different class (class 29/832) than claims 1-16 (class 361/760). The requirement is still deemed proper and is therefore made FINAL.

Claims 16-28 are withdrawn from further consideration as being drawn to non-selected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, line 2, it is unclear. What is that meant "... at least one supporting element projecting from **its** surface"? What does "**its**" refer to?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by de Vall (U. S. Patent 5,574,470).

As to claim 1, de Vall discloses an electrical circuit (10, column 3, line 49) as shown in figures 1-10 comprising:

an integrated circuit (50-figure 3, column 4, line 21), an antenna (26;31, column 3, line 62, and column 4, line 7) and one or more electrical connections (66a-66e, column 4, line 62) between-the integrated circuit (50) and the antenna (26), wherein at least the integrated circuit and the antenna are encapsulated within a capsule (58, 60, column 4, lines 27-32 and column 3, line 50); and

wherein the capsule comprises a thermoplastic resin (PVC material-58, 60) having a melting point of from 120°C to 250°C.

As to claim 2, de Vall discloses an electrical circuit as shown in figure 8 wherein the capsule (141, 133) completely encapsulates the electrical circuit (column 10, lines 5-11).

As to claim 3, de Vall discloses an electrical circuit as shown in figure 8 wherein the capsule (141) encapsulates the electrical circuit only on one surface of the electrical circuit.

As to claim 4, de Vall discloses an electrical circuit as shown in figures 1-10 wherein the electrical circuit is encapsulated within the capsule such that at least one or more electrical connections are encapsulated by the thermoplastic resin.

As to claim 5, de Vall discloses an electrical circuit as shown in figures 1-10 wherein the antenna is a coil (column (column 3, line 62).

As to claim 6, de Vall discloses a transponder as shown in figures 1-10 comprising:

an electrical circuit (10) containing at least one component suitable for interaction with an electromagnetic field encapsulated within a capsule (figure 1-58, 60 and figure 8-133 and 141, 131 and 135),

wherein the capsule comprises a thermoplastic resin (PCV material) having a melting point of from 120°C to 250°C, and wherein the electrical circuit is encapsulated by the thermoplastic resin such that at least an integrated circuit (50) and an antenna (26) of the electrical circuit are encapsulated by the thermoplastic resin.

As to claim 7, de Vall discloses a transponder as shown in figures 1-10 wherein the thermoplastic resin consists essentially of thermoplastic polyamide (column 3, lines 49-50, column 6, lines 7, 22-30, column 8, lines 32-36, and column 10, lines 19-21) .

As to claim 8, de Vall discloses a transponder as shown in figures 7-8 wherein at least part of a surface of the capsule is covered with a cover layer of laminated film (131, 135).

As to claim 9, de Vall discloses a transponder as shown in figures 6-8 wherein the laminated film comprises a plastic (column 4, lines 31-32, column 9, lines 18-19, 60-62).

As to claim 10, de Vall discloses a transponder as shown in figures 1-10 wherein the plastic is polyvinyl chloride (column 4, lines 31-32).

As to claim 11, de Vall discloses a transponder as shown in figures 1-10 wherein the antenna is a coil (column 3, line 62).

As to claim 12, de Vall discloses a transponder as shown in figures 1-10 wherein the electrical circuit further comprises one or more electrical connections (66a-66e) connecting the integrated circuit (50) in electrically conducting fashion with the antenna (26).

As best understood to claim 13, de Vall discloses a transponder as shown in figure 8 wherein the capsule further comprises at least one supporting element (131, 135) projecting from surface of integrated circuit (50).

As to claim 14, de Vall discloses a transponder as shown in figures 1 and 6-8 wherein the capsule includes a material used as a mold during encapsulation with the thermoplastic resin (column 2, lines 38-46, column 4, lines 27-54, column 5, lines 28-35, column 6, lines 5-8, 23-30).

As to claim 15, de Vall discloses a transponder as shown in figure 8 wherein the transponder further comprises a sheath (141, 131) of injection-molded resin surrounding the encapsulated electrical circuit.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dunn et al., Pollack et al., Lauro et al., Gustafson, Lee, Jr. et al., Brady et al., Lake, and Kulka et al. disclose related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3431 for regular communications and 703-308-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-9560.

TD
August 13, 2001

A handwritten signature in black ink, appearing to be 'M. Gaffin', written in a cursive style.